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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/607,538

06/27/2003

Caius Rommens

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EXAMINER

FOX, DAVID T

ART UNIT

PAPER NUMBER

1638

MAIL DATE

DELIVERY MODE

03/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/607,538	Applicant(s) ROMMENS ET AL.	
	Examiner David T. Fox	Art Unit 1638	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 February 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): see attachment.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 3, 5, 13 and 44-55.
Claim(s) withdrawn from consideration: 56 and 57.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Attachment to Advisory Action. (Item 3)

New issues: Replacement of "border-like" with "promotes and facilitates integration..." changes the scope of the claim, raising new 112 first paragraph issues and possibly art issues. From the definition on paragraph 44 of the spec, it appears that the sequences having the newly claimed functions may be a subgenus of all "border-like" sequences (note the recitation of "In a preferred embodiment"), or vice versa.

Failure to materially simplify: Amendment does not obviate 112 first paragraph and art rejections.

Item 5. Amendment to claims 44 and 49-52 would have addressed 112 second paragraph rejections of record. Remarks on paragraph bridging pages 5 and 6 of amendment obviate new matter rejection of record.

Item 11. Re 112 first rejections, claims remain broadly drawn to any sequence of any length, including 5-100 nt, which genus is much broader than the genus demonstrated to have "border-like" (or integrative) function. Contrary to Applicant's assertions, the Examiner did not suggest the amendment of claim 3 (regarding replacement of "border-like" with another phrase) during the interview of 03 January 2007. Examiner suggested amendment to recite consensus sequence, and opined that in the absence of such an amendment, amending the claims to indicate that the "border-like" sequence was from a plant *might* address the 112 first paragraph issues, pending consultation of Tech Center Quality Assurance Specialists. Applicant's arguments re TATA box or T-DNA border recitations in other patents are not persuasive, since these sequences are much smaller than the instantly claimed sequences, and are much better

Art Unit: 1638

characterized and well-known. Applicant's sequences are a new class of sequences, and theoretically encompass as much as 100 base pairs, while Applicant has characterized only 25 base-pair sequences.

Re art rejection, amended claim 13 does not stipulate that the 5-100 nt portion of the integrative sequence not be identical to a T-DNA border sequence. Instead, the claim merely recites that the *entire* plant-derived integrative sequence not be identical to a T-DNA border sequence. The claimed 5 nt-long sequence is indistinguishable from any random sequence found in the genome of the plant taught by McElroy, or found in the vector taught by McElroy to transform the plant, including linker sequences. Applicant's argument that McElroy does not teach the claimed invention, because a single nucleotide found in the genome of the plant taught by McElroy would be identical to a single nucleotide found in a T-DNA border, is not persuasive. Using the same logic, a single nucleotide found in the claimed non-T-DNA plant integrative sequence would also contain a single nucleotide which could be found in a T-DNA border, thus rendering the claim inoperative.

DAVID T. FOX
PRIMARY EXAMINER
GROUP 480 1638

